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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,766	04/16/2004	David M. Binder	7226-208	8796

7590 02/09/2005

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EXAMINER

GIBSON, KESHIA L

ART UNIT PAPER NUMBER

3761

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/825,766	BINDER ET AL.	
	Examiner	Art Unit	
	Keshia Gibson	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12, 14, 15 and 28-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 12, 14, 15 and 38-42 is/are allowed.
- 6) ☒ Claim(s) 6-9 and 28-37 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/16/04 & 9/3/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 9/03/04 appears to contain an error: reference to US 32,991 should be US RE 32,991. The examiner has considered US RE 32,991 for the purposes of this office action and has been noted on the returned copy of applicant's IDS.

Specification

2. The use of the trademarks LYCRA and BEN-GAY have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6-7 and 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Docter (US 6,143,946).

Art Unit: 3761

In regard to Claim 6, Docter discloses a stretchable, supportive wrap **10** (column 2, lines 17-24). The wrap **10** has a gel layer **14**, a stretchable carrier **12**, and closure strips **16** (column 2, lines 17-24). It has been held that the prior art inherently performs a claimed method when that prior art meets the structural limitations of the article of the claimed invention and is used in normal and usual operation (see MPEP 2112.02). It is considered normal and usual operation to stretch a stretchable wrap around a portion of the body then secure the wrap in a closed position with closure strips or fasteners. (Also see Docter's disclosure for mention of this operation in column 3, lines 8-14). Therefore, Docter anticipates the method of the claimed invention.

In regard to Claim 7, Docter discloses the gel layer **14** comprises a hydrogel (column 3, lines 42-62).

In regard to Claims 28-33, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 9, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Docter.

Art Unit: 3761

In regard to Claim 8 and 34, Docter discloses the claimed invention except for the gel layer comprising a silicone gel, and such gel further being a polydiorganosiloxane resin. However, applicant discloses that: "There is no reason to limit our device to silicone gel, if there are other gels that provide clinical benefit." Docter discloses that the hydrogel **14** is bacteriostatic (inhibits the growth and multiplication of bacteria) (column 2, lines 42-43). Thus, based on applicant's own admission, the hydrogel disclosed by Docter is equivalent to the silicone gel of the claimed invention. As a result, the claimed invention is not considered patentably distinct from the prior art.

In regard to Claim 9, Docter discloses the claimed invention except for the stretchable carrier **12** having an elastic modulus of about 50%. However, Docter does disclose that the stretchable carrier **12** is elastic enough to cover a body part yet inelastic enough to maintain the wrap in a fixed position (column 3, lines 32-41). It would have been obvious to one of ordinary skill in the art to provide the stretchable carrier with an elastic modulus of about 50%, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

In regard to Claim 35, Docter discloses that the gel layer **14** may comprise therapeutic additives (column 2, line 54- column 3, line 7).

In regard to Claim 36, Docter discloses that the therapeutic additives may include emollients (column 1, lines 25-34; column 2, line 54 – column 3, line 7).

7. Claims 8, 9, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Docter in view of Pocknell (US 4,991,574).

Art Unit: 3761

In regard to Claim 8, Docter discloses the claimed invention except for a gel layer that is a silicone gel. Pocknell discloses a stretchable, supportive bandage comprising a gel layer **2** bonded to a stretchable carrier **3** (column 1, lines 57-61; Figure 1). Pocknell further teaches the use of a silicone gel layer to aid in the treatment of hypertrophic scarring (column 1, lines 42-46). Thus, it would have been obvious to one of ordinary skill in the art to modify the wrap of Docter in order to provide for a silicone gel as taught by Pocknell since doing so would allow the wrap to aid in the treatment of hypertrophic scarring.

In regard to Claim 9, as discussed previously, Docter discloses the claimed invention except for the stretchable carrier **12** having an elastic modulus of about 50%. However, Docter does disclose that the stretchable carrier **12** is elastic enough to cover a body part yet inelastic enough to maintain the wrap in a fixed position (column 3, lines 32-41). It would have been obvious to one of ordinary skill in the art to provide the stretchable carrier with an elastic modulus of about 50%, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

In regard to Claim 34, Pocknell discloses that the silicone gel may be a polydiorganosiloxane resin (column 2, lines 4-32).

In regard to Claims 35-36, Pocknell discloses that the wrap **10** may include additives typically employed in the treatment of burns and wounds (column 4, lines 26-35).

In regard to Claim 37, the closure strips **16** are approximately the same width as the wrap **10** (Figure 4; column 3, lines 8-22).

Allowable Subject Matter

8. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 11-12, 14-15, and 38-42 are allowed. The art of record teaches bandages or wrap with layers comprising silicone as well as elastic and supportive materials in order to provide simultaneous application of silicone and pressure therapies. However, the art of record fails to teach a wrap comprised of an elastic hook-and-loop-type support with a coating of silicone gel. Thus, the art of record fails to teach a method comprising the wrap comprised of a silicone gel and a hook and loop support.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goldstein (US 6,506,175 B1).

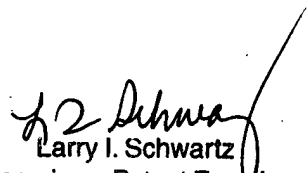
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keshia Gibson whose telephone number is (571) 272-7136. The examiner can normally be reached on M-F 8:30 a.m. - 6 p.m., out of the office every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kg 2/2/05

A handwritten signature in black ink, appearing to be 'KG' followed by a horizontal line.A handwritten signature in black ink, appearing to be 'Larry I. Schwartz'.

Larry I. Schwartz
Supervisory Patent Examiner
Group 3700

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20040202

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